

REMARKS

The Official Action dated September 22, 2005, has been carefully considered. Accordingly, the changes presented herewith, taken with the following remarks, are believed sufficient to place the present application in condition for allowance. Reconsideration is respectfully requested.

Claims 13-15 are pending in the application. Claims 1-12 have been previously canceled. In the present Official Action, the Examiner requests clarification on the claim of priority in the present application. The Examiner objects to the drawings because a reference numeral has been used more than once in designating different aspects of the drawings. The Examiner objects to various informalities in the specification. The Examiner objects to claim 1 based on an informality. The Examiner rejects claim 1 under 35 U.S.C. 102(b) as anticipated by Kawada et al. (JP2002229090A, hereinafter "Kawada"). The Examiner rejects claims 14 and 15 under 35 U.S.C. 103(a) as unpatentable over Kawada in view of Bahmanyar et al. (U.S. Patent 6,066,128, hereinafter "Bahmanyar").

Regarding the priority claim in the present application, Applicants have amended the specification to include the priority claim to U.S. Application Serial No. 10/189,675, now U.S. Patent No. 6,786,628. Note that a claim for priority was filed with the original application in the present case on October 30, 2003, as part of the Utility Patent Application Transmittal. A copy of this Transmittal is attached for the convenience of the Examiner. This claim of priority was recognized by the USPTO in the first filing receipt dated February 2, 2004. As such, Applicants believe that no further petition or surcharge is required to perfect the priority claim.

Regarding the objection to the Drawings, Applicants have corrected Fig. 1 to remove the reference numeral "34". Please see the attached Replacement Drawing page. Applicants have also amended the specification on pages 5 and 6 to correct the inadvertent typographical error designating reference character "34" as a shutter arrangement.

Applicants have amended the specification to correct various typographical mistakes. Many of the amendments are in accordance with the Examiner's suggestions in

order to address his objections on informalities in the text. Applicants thank the Examiner for bringing several of these typographical mistakes to our attention.

Regarding the objection to claim 1, Applicants have amended claim 1 to recite in pertinent part: “the needle including a lumen” to clarify the meaning of “lumen.” In contrast to the Examiner’s indicated definition of “lumen” in terms of illumination intensity, “lumen” is used in the present application to mean a “needle lumen” (See, e.g., specification at page 3, line 31 through page 4, line 2). Further, the specification at page 8, lines 26-27, referring to Figs. 8 and 9, states: “A lumen 140 enables communication between the LED 126 and the power source 124 with an electrical connection 144.”

Applicants have amended claim 13 and 14 to more clearly claim certain aspects of the present invention. The amendments to claim 13 are supported at least by Figs. 1 and 8 and accompanying text for those figures. The amendments to claim 14 are supported at least by Figs. 1 and 9 and accompanying text for those figures. No new matter has been added by any of these amendments.

Applicants respectfully traverse the rejection of claim 13 under 35 U.S.C. 102(b) over Kawada. Amended claim 13 states in pertinent part: “wherein the LED and the power source are disposed within the housing”, and “said power source being disposed at a proximal end of said housing.” Kawada fails to teach these elements. Kawada states in its Abstract and in paragraphs [0008] and [0012] that the battery can be arranged in the suction unit. The suction unit appears to be the console and is separate from the handpiece or syringe (i.e. the suction unit is separated from the handpiece by a flexible hose, see, e.g., paragraph [0002] of the translation). As such, Kawada does not teach or suggest including a power source in the housing of the hand held light source, and claim 13 should be allowed accordingly. As claims 14 and 15 depend from claim 13, claims 14 and 15 should be allowed for the same reasons that claim 13 is allowable.

Further regarding the rejection of claims 14-15 under 35 U.S.C. 103(a), in addition to the arguments above regarding Kawada, Bahmanyar also does not teach a power source disposed within the housing. Also, Kawada is in a non-analogous art field, as it is directed

to dentistry and not eye surgery. Regarding claim 15, the Examiner acknowledges that Bahmanyar does not teach a lens having an “hourglass shape.” Applicants respectfully submit that the shape of a lens is not the type of element that is a mere change of shape or form, as it has optical effects as the Examiner notes. This is not the type of shape change contemplated by the *Span-Deck* case cited by the Examiner. The *Span-Deck* case is a case in which the finding of obviousness is based on a number of prior art references that teach the elements of the invalidated patent, just in different shapes and orientations. In contrast, here the Examiner cites no prior art references or other evidence for his assertion of obviousness. Applicants believe the Examiner is essentially improperly making an inherency argument and/or an argument on the knowledge of one skilled in the art without citing any support therefore and without showing that the hourglass shape necessarily follows from anything in the cited art. Applicants respectfully request the basis and evidentiary support for the Examiner’s assertions, otherwise Applicants believe the Examiner has failed to carry his burden to put forth a prima facie case of obviousness.

Thus, Applicants respectfully submit that the claimed invention is not anticipated nor made obvious by any of the cited references.


CONCLUSION

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reconsideration and allowance of all pending claims at an early date is respectfully requested.

Applicants believe that no fees are due in accordance with this Amendment beyond those included herewith. Should any additional fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account 502317.

Respectfully submitted,

Date: December 19, 2005

A handwritten signature in cursive script, appearing to read "Scott J. Catlin", is written over a horizontal line.

Scott J. Catlin, Esq.
Registration No. 52,709

ADVANCED MEDICAL OPTICS, INC.
1700 East St. Andrew Place
Santa Ana, California 92705
Phone: 714.247.8463
Fax: 714.247.8679